

Notice of Allowability

Application No.

10/628,649

Examiner

Rei-tsang Shiao, Ph.D.

Applicant(s)

BESTERMAN ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed on November 09, 2006.
2. ☒ The allowed claim(s) is/are 5,7,16,18,22-24,56 and 58-65, now are 1-16.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

1. Amendment of claims 5, 7, 16, 18, 23, 51, 53, 56, 58 and 60, cancellation of claims 1-4, 6,8-15, 17, 19-21, and 25-50, addition of claims 62-65 in the amendment filed on November 09, 2006, is acknowledged. Claims 5, 7, 16, 18, 22-24, 51, 53-56, 58-65 are pending in the application. No new matter is found. Since the newly added claims 62-65 are commensurate with the scope of the invention, claims 5, 7, 16, 18, 22-24, 51, 53-56 and 58-65 are prosecuted in the case.

Responses to Amendment/Arguments

2. Applicant's arguments regarding the rejection of claims 51 and 53-55 under 35 U.S.C. 112, first paragraph, filed on November 09, 2006, have been fully considered but they are not persuasive. The rejection of claims 51 and 53-55 under 35 U.S.C. 112, first paragraph is maintained. Since claim 52 has been cancelled, the rejection of claim 52 under 35 U.S.C. 112, first paragraph has been obviated herein.

EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee. Authorization for this examiner's amendment was given in a telephone interview with Joseph C. Zuccherro on November 27, 2006. The application has been

amended as follows:

Delete claims **51 and 53-55**.

Reasons for Allowance

4. The following is an examiner's statement of reasons for allowance:

Claims 5, 7, 16, 18, 22-24, 56 and 58-65 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to Acyl phosphonate inhibitors of beta-lactamase. The closest reference is Beterman et al. US 6,472,406, which discloses sulfonamidomethyl phosphonate inhibitors of beta-lactamase. The difference between the reference and instant claims is that instant claimed compounds/compositions of formula (II) have not been found. A suggestion for modification of above reference to obtain the instant claimed compounds/compositions of formula (II) and methods of use has not been found. Claims 5, 7, 16, 18, 22-24, 56 and 58-65 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".


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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626



Robert Shiao, Ph.D.
Patent Examiner
Art Unit 1626

November 27, 2006